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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,242	01/09/2004	Mark Robert	077196-0025	7772
1923 7590 08/22/2007 MCDERMOTT, WILL & EMERY LLP 227 WEST MONROE STREET SUITE 4400 CHICAGO, IL 60606-5096			EXAMINER STULII, VERA	
			ART UNIT 1761	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/754,242	Applicant(s) ROBERT, MARK	
	Examiner Vera Stulii	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specification discloses presence of stabilizers in claimed invention. It was well known in the art that disclosed stabilizers provide emulsifying properties as well as stabilizing properties. Specification does not provide examples or guidance regarding a product without an emulsifier.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-18 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites absence of emulsifier and presence of stabilizer. Claim 16 recites carrageenan and guar gum as examples of stabilizers. It was well known in the art that carrageenan and guar gum provide emulsifying properties as well as stabilizing properties. Therefore elimination of emulsifiers conflicts with presence of stabilizers i.e. gums which may act as emulsifiers.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hussein (US 6,197,362).

Reference and rejection are incorporated herein as cited in the previous Office Action.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussein (US 6,197,362) in view of Dairy Foods.

References and rejection are incorporated herein as cited in the previous Office Action.

Response to Arguments

The rejection of claims of 4 and 6 under 35 U.S.C. 112, second paragraph has been withdrawn in light of claims Amendments.

Applicant's arguments filed June 5, 2007 have been fully considered but they are not persuasive.

On page 4 of the Reply to the office Action mailed December 1, 2007, Applicant states that "Applicant respectfully requests withdrawal of the rejection of claims 1-18 under 35 U.S.C. 112, first paragraph, in view of the discussion below, and because Applicant's examples do not contain an emulsifier". It is noted that examples presented in the Specification is not a part of claimed invention. As stated in the previous Office Action, claim 10 recites absence of emulsifier and presence of stabilizer. In the same time, claim 16 recites carrageenan and guar gum as examples of stabilizers. It was well known in the art that carrageenan and guar gum provide emulsifying properties as well as stabilizing properties, and therefore were well known in the art emulsifiers. Therefore elimination of emulsifiers conflicts with presence of stabilizers i.e. gums which may act as emulsifiers. Claims 1-18 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons stated above and below and also for the reasons of record stated in the previous Office actions.

On page 4 of the Reply Applicant state that "The present invention is directed to a dairy-based pourable dessert topping without an emulsifier". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., lack of emulsifier) are not

recited in the rejected claims (claims 1-9). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 4 of the Reply Applicant states that "because Hussein does not teach each and every element of the present invention, Applicant's invention is not anticipated by Hussein". Examiner respectfully disagrees. It is noted that claim 1 recites the phrase "comprising" and ^{none}~~none~~ of claims 1-9 recite the absence of emulsifier.

Again and as stated in the previous Office Action, in regard to claims 1-9, Hussein discloses pourable dessert liquid product comprising from about 2 weight % to about 20 weight % milk solids nonfat (Col. 1 lines 58-59), from about 4 weight % to about 35 weight % sweetener (Col.2 lines 4-5), from about 1 weight % to about 15 weight % of fat (Col.1 line 64-65), from about 0.01 weight % to about 2.0 weight % of stabilizer (Col.2 line 11-16), from about 0.1 weight % to about 2 weight % of flavoring agent (Col.2 lines 17-23).

In regard to claim 2, Hussein discloses that milk solids nonfat include dried skim milk, whey protein and milk protein concentrate (Col.1 line 58-59).

In regard to claims 3 and 4, Hussein discloses dairy fats, dairy crèmes, and the like (Col.2 lines 1-2).

In regard to claim 5, Hussein discloses sweeteners such as sucrose and corn syrup (Col.2 lines 7-10).

In regard to claim 6, Hussein discloses high fructose corn syrup, sucrose, dextrose, and corn syrup (Col. 2 lines 7-10).

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In regard to claim 7, Hussein discloses stabilizers such as carrageenan, guar gum, locust bean gum, xanthan gum, cellulose, modified cellulose, hydrocolloids and the like (Col. 2 lines 11-16).

In regard to claim 8, Hussein teaches that the pourable dessert product may be incorporated into food products where condensed and/or evaporated milk is called for such as custards, creme brulee and the like (Col. 2 lines 35-37). It is also noted that Hussein teaches use of dairy crèmes (Col. 2 lines 1-2) as a fat component for pourable dessert. Therefore the resulting product comprises combination of dairy crème, evaporated milk, and condensed milk, which makes it "tres leches" dairy mix.

In regard to claim 9, Hussein discloses soaking a suitable cake with an appropriate amount by weight of the pourable dessert liquid mix (Col. 2 lines 49-50).

Thus, Hussein (US 6,197,362) disclose every element claimed in claims 1-9, and claims 1-9 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hussein (US 6,197,362).

On page 6 of the Reply Applicant state that "[t]here is no teaching in Hussein that the emulsifier can be eliminated or substituted with something else, and therefore Hussein teaches away from the present invention". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On page 6 of the Reply Applicant state that "Applicant respectfully submits that combination of the cited references is improper, but even if proper, Applicant's invention is patentable over the combination of references". Examiner respectfully disagrees. As stated above, Hussein (US 6,197,362) disclose every element claimed in claims 1-9. Claim 10 differs from claim 1 in recitation of absence of emulsifier. Reference Dairy Foods ("New Heights in Emulsifier Technology – Elimination of Polysorbate 80 from Dairy Food Formulations") discloses elimination of emulsifiers such as Polysorbate 80 from dairy dessert compositions (ice cream, ice milk, frozen yogurt and sugar-free products). Dairy Foods discloses that polysorbate 80 possibly causes cancer (p. 1 § 2). Dairy Foods also disclose that a stabilizer/emulsifier blends have been developed that can eliminate polysorbate 80 from dairy food formulations, while maintaining or even improving finished product quality (p. 1 § 4). Dairy Foods also disclose that the new stabilizer/emulsifier blends replaced emulsifying system in a range of frozen dairy desserts, including traffic brand and premium ice cream, ice milk, frozen yogurt and sugar-free products (p. 1 § 5). Dairy Foods also disclose that ingredients such as "locust bean gum, cellulose gum, guar gum and carrageenan" are used in the new emulsifying blends. It was well known in the art that carrageenan and guar gum provide emulsifying properties as well as stabilizing properties, and therefore were well known in the art emulsifiers and stabilizers at the same time. Since Hussein discloses use of ingredients such as carrageenan, guar gum, locust bean gum, etc. (Col. 2 lines 11-16), and Dairy Foods teaches use of locust bean gum, cellulose gum, guar gum and carrageenan in emulsifying blends, it would have been obvious to one skilled in the art to employ locust

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bean gum, cellulose gum, guar gum and carrageenan as an emulsifying blend in order to remove "chemically sounded" emulsifiers and still maintain or even improve finished products quality as taught by Dairy Foods.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Stulii whose telephone number is (571) 272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vera Stulii



KEITH HENDRICKS
PRIMARY EXAMINER